REMARKS

In the Office Action mailed October 7, 2004, the Examiner rejected claims 3, 6, 9, 12, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite (Office Action [hereinafter "OA"], paragraphs 3 and 4); rejected claims 1-18 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by Capps (U.S. Patent No. 5,544,295) (OA, paragraphs 5 and 6); and rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Capps in view of Nielsen (U.S. Patent No. 5,784,056) (OA, paragraphs 7 and 8).

In view of the remarks that follow, Applicants respectfully traverse the Examiner's rejections of the claims under 35 U.S.C. §§ 102(b), 103(a), and 112.

I. Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 3, 6, 9, 12, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner alleged that there is insufficient antecedent basis for the term "the numbers and types" in line 2 of claims 3 and 9 and lines 2-3 of claims 6 and 15. (OA, paragraph 4). Applicants traverse. Each of claims 3, 6, 9, and 15 refers to "the number and types of the objects" or "the number and types of objects of the container." So "the number and types" is referring to "objects." Inherent components of elements recited have antecedent basis in the recitation of the components themselves. M.P.E.P. § 2173.05(e). In this case, "the number and types" are inherent components of objects. Accordingly, Applicants respectfully submit that this rejection is overcome and should be withdrawn.

II.   Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-18 and 29-31 under 35 U.S.C. § 102(b) as being anticipated by Capps. Applicants respectfully traverse this rejection. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in...the claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed., 2001), p. 2100-69.

Regarding claim 1, the Examiner alleged that the references teach "determining based on the detected event whether an animated sequence does not reflect the state of the container," pointing to col. 8, lines 37-40 and col. 7, lines 63-65 of Capps in doing so. Applicants respectfully disagree with the Examiner's interpretation of the reference.

Capps discloses a method that includes the steps of: a) determining an action to be take on an object on a computer screen which changes the status of the object; b) modifying the visual appearance of the object through animation to reflect the change in status; and c) automatically moving the modified object on the screen to indicate the disposition of the object (abstract). In rejecting claim 1, the Examiner refers to col. 8, lines 37-40 and col. 7, lines 63-65 of Capps as an alleged teaching of "determining based on the detected event whether an animated sequence does not reflect the state of the container." The Examiner expands on the reasons for rejection, noting:

> based on user activation, a determination is made whether
> an animated sequence reflects the state of the container,

e.g. an animation cycle of an object slipped into a file folder and moving across the screen into an open drawer reflects the activity of an object to be filed, and the image/cyclical display is updated upon completion with the image being removed as a determination that the process is complete.

OA, page 4, 1st paragraph.

Neither the portion of <u>Capps</u> cited by the Examiner nor anything else in <u>Capps</u> shows "determining based on the detected event whether an animated sequence does not reflect the state of the container." For example, assuming arguendo, that the portions of <u>Capps</u> pointed to by the Examiner shows that <u>Capps</u> teaches detecting an event reflecting a change in the state of container and updating a corresponding cyclical display, nothing in <u>Capps</u> suggests the extra step of "determining based on the detected event whether an animated sequence does not reflect the state of the container," as alleged by the Examiner. Removing an image upon completion of a process, or otherwise altering the animation of <u>Capps</u> is not tantamount to "determining based on the detected event whether an animated sequence does not reflect the state of the container." Altering the animation in this manner is only an update of the animation. These updates occur every time there is a modification (e.g., an object to be filed), thus wasting valuable time if it turns out that the animation does not have to be changed at all. There is no quality control as to whether the update is needed.

Moreover, Applicants respectfully submit that neither the cited portion nor anything else in <u>Capps</u> shows "detecting an event reflecting a change in the state of the container, wherein the container implements a discussion forum."

Because <u>Capps</u> fail to teach or suggest the features that the Examiner asserts, <u>Capps</u> does not anticipate claim 1. Accordingly, Applicants submit that the rejection of

claim 1 is unsupported by <u>Capps</u>. Independent claims 7 and 13, although different in scope, recite language similar to that which distinguishes claim 1 from <u>Capps</u>. Applicants therefore submit that the rejections of claims 7 and 13 are unsupported by <u>Capps</u> for at least the reasons given with respect to claim 1.

The rejections of dependent claims 2-6, 8-12, 14-18, and 29-31 are unsupportable for the reasons stated above with regard to their respective base claims. Moreover, Applicants respectfully submit that these claims are distinguishable over <u>Capps</u> for their own features.

III.   Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over <u>Capps</u> in view of <u>Nielsen</u>. Applicants respectfully traverse this rejection because a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143.03 (8th ed. 2001)).

Regarding claim 32, similar to claim 1 the Examiner alleged that the references teach "determining based on the detected event whether an animated sequence does not reflect the state of the container," pointing to col. 8, lines 37-40 and col. 7, lines 63-65 of <u>Capps</u> in doing so. Applicants respectfully disagree with the Examiner's

interpretation of Capps with respect to this feature, as noted above with reference to the discussion on claim 1.

Nielsen is not sufficient to overcome the aforementioned deficiencies of Capps. Nielsen discloses a system in which an object to be pointed to in a user's display is indicated with an animated pointer icon (abstract). This configuration disclosed by Nielsen, however, does not include a step of "determining based on the detected event whether an animated sequence does not reflect the state of the container." Moreover, Applicants note that the Examiner used Nielsen to allege a teaching of a container that is a web page related to user discussion, not to allege a teaching of "determining based on the detected event whether an animated sequence does not reflect the state of the container."

With respect to the Examiner's allegation that Nielsen shows a container that is a web page related to user discussion, Applicants submit that this allegation is also made in error. The Examiner specifically refers to col. 5, lines 30-43 and col. 1, lines 45-48 of Nielsen, further stating/alleging that a web page includes a stream of bits wherein users may select a location for the image of the temporally varying icon to inserted into the HTML bit stream of the web page or overlaid on the object that is of interest (OA, page 7). Contrary to the Examiner's allegation, neither the portion cited by the Examiner nor anything else in Nielsen shows a container that is a web page related to user discussion. Nielsen discusses web pages in general, but never touches on a web page related to user discussion.

The Examiner has also failed to provide a proper motivation to combine the references. The motivation to combine alleged by the Examiner is based on providing

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an intuitive and aesthetically pleasing indication of the change in status of an object overlaid on a container. This contradicts the Examiner's earlier allegations that Capps is concerned with changes in the state of a container.

Moreover, Applicants respectfully submit that nothing that the Examiner emphasized nor anything else in Nielsen, alone or in combination with Capps, shows "detecting an event reflecting a change in the state of the container, wherein the container is a container that tracks e-mail discussion threads."

Because the references, alone or in combination, fail to teach or suggest the features that the Examiner asserts, and because the Examiner has not provided a proper motivation to combine the references, a *prima facie* case of obviousness has not been established. Accordingly, Applicants submit that the rejection of claim 32 is unsupported by Capps in view of Nielsen.

IV. Conclusion

Because none of the Examiner's rejections of the claims are supportable, each of the claims is allowable. Accordingly, Applicants respectfully request the timely allowance of this application.
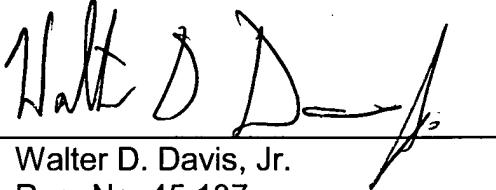
If an extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Amendment, such extension is requested. If there are any other fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 4, 2005   By:_____
                                          Walter D. Davis, Jr.
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